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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,259	07/24/2003	Zhong Ding	961_013NP	9582
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Hiscock & Barclay, LLP One Park Place 300 South State Street Syracuse, NY 13202-2078			EXAMINER GORDON, BRIAN R	
			ART UNIT	PAPER NUMBER
			1797	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/626,259

Applicant(s)

DING ET AL.

Examiner

Brian R. Gordon

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-27-08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,9 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,9 and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1448 or PTO-889)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed May 27, 2008 have been fully considered but they are not persuasive. Applicant asserts the claims have been amended such the fluid is "specifically and positively a component". The examiner disagrees. It should be noted an invention is not generally defined by the preamble but is defined by the elements following the transitional phrase (comprising). The preamble states "In combination a metering tip to aspirate and dispense a quantity of fluid". The phrase "to aspirate and dispense a quantity of fluid" is directed to intended use. For example, if a claim were directed to "a chair to allow a person to sit thereon; the chair comprising a horizontal surface, four legs, etc.", the person would not be considered to an element of the chair. The phrase to allow a person to sit thereon is directed to intended use. Applicants claim does not recite a metering tip comprising or including a fluid in an interior of the tip or any variation thereof such that one would consider the fluid a structural element of the device.

Applicant asserts claims 1 and 6 are directed to a combination that comprises a metering tip and the fluid. As clearly explained above, the fluid is not positively claimed as an element of the device. However the claim appears to be directed to a combination of a metering tip and a metering apparatus, wherein the metering tip is attached to the metering apparatus. Even if the fluid were positively claimed, the fluid would not be a novel feature of the device.

As to claim 6, it is unclear what elements consider as defining the combination. As previously stated the fluid is not positively claimed, and the phrase "being attachable" means the tip is capable of being attached to a metering apparatus, but is not the same as a metering tip attached to a metering apparatus. As such, the amendment has not affected the scope of the claim. The combination only requires the metering tip therefore it is not a combination as indicated.

On page 7, applicant further states "distinguishing characteristics between the cited art and Claims 1 and 6." Applicant asserts the prior art (Hughes) must disclose a read window for spectrophotometric optical analysis. The issue of the read window has been previously addressed and will be repeated herein. As previously stated applicant "optical read window" is not structurally distinguished from any other portion of the wall of the tip. The entire tip is made of the same transparent material. Applicant has elected to refer to a portion of the wall as an "optical read window". Any portion of the wall can be referenced as such. Furthermore the remarks directed to the permission of spectrophotometric analysis are directed to how the device is intended to be used. If applicant intends for the device to be limited to the use in spectrophotometric analysis then applicant should consider filing an application with claims directed to the use of the device in method directed to such a spectrophotometric analytical process. Furthermore the argument is not commensurate in scope with the claim. The only structural requirement is the device is comprised of material (transparent or otherwise) that allows for some type of optical analysis (including manual viewing with the human eye or other instrumental optical analysis).

Applicant further elaborates on the "goals" of retaining fluid and no interruptions of entering and exciting light. Such goals are not commensurate in scope with that of the instant claims. The claims are directed to a structure not a process of using the device. The arguments must directed to distinguishing the instant invention from the prior art based on structural differences not the intended use or intend goals one seeks to achieve by such a device.

Applicant further asserts the device of Hughes is not capable of retaining fluid unless it is used alone. The examiner disagrees. The bottle is equivalent to the claimed metering apparatus such that one can squeeze the bottle to dispense liquid and release such pressure to aspirate a fluid (as shown in Figures 3-4.).

Applicant further states Hughes fails to include an axial portion that defines a read window. The examiner disagrees. By "axial cylindrical portion" this directed to the wall of the plastic body. As explained above the "read window" structure of Hughes is defined by the wall of its body portion. On page 7, applicant states the "read window" is not the novel aspect of the invention. However applicant continuously present arguments directed to such read window. If the read window is not the novel structural limitation, then what does applicant considers being the novel **structural** limitation(s).

Applicant makes further assertions that are not commensurate in scope with that of the claims. It is unclear how applicant is providing for structural differences by asserting the prior art requires viewing through multiple plastic layers, the fluid is not retained in the cap, and the screw threads are along the entire interior of the peripheral

of the cap. However, number of layers of plastic through which the viewing occurs is not an issue of the claim. Furthermore, there is nothing that precludes one from being able to view the liquid through multiple layers. Furthermore, as seen in Figures 3-5, the bottle maybe inserted into to cap to a point which it abuts against the first indented step portion. As such, there is not a complete overlap of the bottle and cap structures. On in other words, the bottle does not extent to the tip opening of the cap as asserted by applicant. Therefore the portion of the tip which does not overlap may allow for viewing. Furthermore, figures 3-4 clearly shows the cap with fluid retained therein.

As to the combination of Lukacs et al. and Treptow et al., applicant asserts Lukacs et al fails to teach the ring like sections are for the same purposes or solving the same problems as that recited by applicant. While the prior art **may** address the same purposes or problems, it is not required. It is only required that the prior art provided for some motivation to combine the references. That motivation does not have to be the same as applicant's motivation.

As to disclosing where the specific method is supported in the original specification, applicant has attempted to rely upon sporadic portions of the specification and the drawings. While the drawings may provide support for structural limitations, the drawings do not provide support for the specific method as claimed. None of the drawings are tables, include in text, include captions detailing any process limitations, or show any stepwise progression of the method. Applicant asserts that the written requirement is that there be adequate support in the specification to prove that Applicant had knowledge of the claimed subject matter at the time of the filing the

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application. The examiner asserts the written description does not meet the requirements as previously explained in the prior Office Action.

. In view of the remarks of above and those of the previous Office Action the claims are rejected as given herein.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what elements define the combination. See response to arguments.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9 and 12-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While claim 9 was in the originally filed

application, it has been amended to incorporate steps that were not previously claimed. Claims 12-16 were not originally filed in the application.

Claim 16 suggests a method comprising the steps of aspirating a first a fluid volume from a source, dispensing portions of said first volume to one reaction device, and subsequently aspirating the remaining portions of the first fluid volume into the tip. How can one aspirate the remaining portions of the initial fluid when the previous step already establishes the initial volume has already been aspirated? Where is there support for such a method? There is no antecedent basis for "the remaining volume of fluid in claim 16". Claim 13 does not state that there is remaining fluid after the dispensing step. Where is the remaining fluid?

It is hereby requested applicant state where each of the steps incorporated the claims are supported in the original specification to ensure new matter has not been incorporated in the claims.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes US 3,449,081.

Hughes discloses a tapered, plastic cap (tip) that includes upper and lower openings and stepped portions therein (see Figures 4 and 6). As given herein above, the examiner asserts the device of Hughes is equivalent to the claimed structure.

While Hughes specifies the cap is plastic (column 3, line 52), it is not specifically recited that the plastic material is transparent or clear. However, it should be noted that the reference does not state the cap is not clear or transparent as asserted by applicant.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the plastic material of the cap maybe transparent. It is conventionally known that plastic materials maybe transparent. For example, as admitted by applicant the syringe and bottle of Hughes is manufactured from a clear, plastic material (column 3, line 6)

As to claim 6, the cap is attached to a bottle (metering apparatus) fluid is aspirated and dispensed from such cap. Since the cap is structurally equivalent the affects of such structure on moving fluid as recited would be inherent.

8. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukacs et al., US 3,780,935 and Treptow et al.

Lukacs et al. discloses all of the claimed structural limitations (see figure 6) except for a read window.

Treptow et al. disclose an apparatus for pipetting and photometrically evaluating samples through a window.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the dispensing device of Lukacs et al to incorporate the optical windows as taught by Treptow in order to provide a cap of test kit to allow for "on-the-spot"-analytics of the samples.

It would have further been obvious to recognize the device maybe manufactured from conventional transparent material such as glass or plastic thereby establishing a read window.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/
Primary Examiner
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